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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,646	10/25/2000	Jouko Tenhunen	442-009870-US(PAR)	3188
2512	7590	02/09/2004	EXAMINER YUN, EUGENE	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			ART UNIT 2682	PAPER NUMBER 9

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,646

Applicant(s)

TENHUNEN, JOUKO

Examiner

Eugene Yun

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasper (5,177,780 "IDS") in view of Kaisto (WO 96/25817 "IDS").

Referring to Claim 1, Kasper teaches a method for erasing a notification message in a terminal, which terminal communicates with a network over a radio interface, which method comprises:

storing a specific first information in a specific system outside the terminal (see col. 1, lines 53-55);

storing said notification message in a memory of the terminal (see col. 1, lines 55-57), wherein the method comprises:

contacting from the terminal a specific address for gaining access to said first information (see col. 1, lines 57-62); and

erasing from the memory of the terminal said notification message in response to a specific procedure relating to said contacting (see col. 1, lines 62-63).

Kasper does not teach transmitting to the terminal over said radio interface a notification message as a sign of said storing. Kaisto teaches transmitting to the terminal over said radio interface a notification message as a sign of said storing (see pg. 12, lines 25-32).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Kaisto to said method of Kasper in order to better assure that a subscriber of a cellular network receives all waiting messages.

Referring to Claim 16, the limitations of the Claim are similar to the limitations of the method of Claim 1. The combination of Kaisto and Kasper teaches all the limitations of the Claim for the same reasons as stated in the rejection of Claim 1.

Referring to Claim 2, Kaisto also teaches the first information to which information said terminal gains access is stored in the specific system outside the terminal, for said terminal (see pg. 12, lines 25-32).

Referring to Claim 3, Kaisto also teaches the first information as a message intended for the terminal, which is stored for the terminal in an electric format in the specific system outside the terminal (see first 3 lines of ABSTRACT).

Referring to Claim 4, Kaisto also teaches the message intended for the terminal as one of the following: voice message; video recording message; multimedia message; fax; electronic mail message (see pg. 13, lines 25-28).

Referring to Claim 7, Kaisto also teaches wherein contacting from the terminal said specific address for gaining access to said first information is effected by making a call from the terminal to a specific number (see pg. 12, lines 33-35 and pg. 13, lines 1-2); and

erasing the notification message is effected in response to one of the following procedures: making a call to said specific number; said specific system outside the terminal answering the call; terminating off said call (see pg. 4, par. [0060]).

Referring to Claims 6 and 8, Narusawa also teaches storing in the memory of the terminal said specific number by calling of which the call will connect to said system outside the terminal;

checking when making a call from the terminal, whether the number which is called is said specific number by comparing the number which is called to said specific number stored in the terminal (see ABSTRACT); and

if the number which is called is said specific number, identifying from among the messages that originate from said system outside the terminal, and erasing the identified notification messages (see pg. 4, par. [0060]).

Referring to Claim 9, Kaisto also teaches at least two specific numbers by calling of which the call will connect to said system outside the terminal (see pg. 11, lines 1-9).

Referring to Claim 10, Kaisto also teaches the identification of notification messages carried out by comparing the CLI data (Calling Line Identity) of the messages stored in the memory of the terminal to said specific number stored in the terminal (see pg. 12, lines 5-8).

Referring to Claim 11, Kaisto also teaches storing in advance in the memory of the terminal a reference file, which is for its essential parts identical to said notification message stored in the memory of the terminal (see pg. 14, lines 24-35 and pg. 15, lines 1-3);

said identification of notification messages is carried out by comparing the content of the messages stored in the memory of the terminal to the content of said reference message (see pg. 12, lines 25-35 and pg. 13, line 1).

Referring to Claim 12, Kaisto also teaches said notification message transmitted to and stored in the terminal comprising a message structure and in its message structure, a control bit pattern, which control bit pattern is used for identifying notification messages originating from the system outside the terminal (see pg. 15, lines 4-17).

Referring to Claim 13, Kaisto also teaches the system outside the terminal is one of the following: voice mail system; video recording message system; multimedia messaging system; fax mailbox service; remove mail service (see ABSTRACT).

Referring to Claim 14, Kaisto also teaches the notification message as one of the following: SMS message; WAP message; message according a packet switched protocol (see pg. 13, lines 18-20).

Referring to Claim 15, Kasper also teaches the terminal as one of the following: telephone of a cellular network; computer terminal (see fig. 1).

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kasper and Kaisto in view of Narusawa (US 2002/0006781).

Referring to Claim 5, the combination of Kasper and Kaisto does not teach said specific procedure in response to which said notification message is erased, is one of the following: initiation of contacting said specific address, establishment of contact; disconnecting. Narusawa also teaches said specific procedure in response to which said notification message is erased, is one of the following: initiation of contacting said specific address, establishment of contact; disconnecting (see pg. 4, par. [0060]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to provide the teachings of Narusawa to said method of Kasper in order to better assure that a subscriber of a cellular network receives all waiting messages.

Response to Arguments

4. Applicant's arguments filed 11/21/2003 have been fully considered but they are not persuasive.

In the Kasper reference, the flag, together with the audible notification are both considered to be the "notification message" since the flag must be set in order for the audible notification to be activated. Therefore, the examiner does use the flag in the Kasper reference to denote the claimed "notification message". The flag is set in a "feature data base" which can also be considered as memory. Therefore, Kasper does teach storing a notification message in a memory of the terminal as well as erasing the notification message from the terminal as there is no specific detail in the claim itself that can suggest that the flag in the Kasper reference cannot be used as a notification message. All the claim teaches in that aspect is a notification message of any kind notifying a user that a voice mail or email is stored in another mailbox and that the notification message is erased or cleared when the message is retrieved, all of which is clearly taught in the Kasper reference. The Kaisto reference is introduced simply to show that a notification message being sent over a radio interface instead of originated in a terminal is known in the art.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eugene Yun
Examiner
Art Unit 2682

EY


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